UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,468	01/16/2001	Charles S. Munn	81274A	9096

23685 7590 01/08/2003

KRIEGSMAN & KRIEGSMAN
665 FRANKLIN STREET
FRAMINGHAM, MA 01702

EXAMINER
DYE, RENA

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/761,468	Applicant(s) MUNN ET AL.	
	Examiner Rena L. Dye	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-11 and 13-57* is/are pending in the application.

4a) Of the above claim(s) *2,4,8-11,14-16,20-31,33-45,47-50,52,54,55 and 57* is/are withdrawn from consideration

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5,6,13,17-19,32,46,51,53 and 56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☑ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species Group I - (D) synthetic cis-1,4-polyisoprene and its copolymers and Species Group II - (b) a glove in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant has stated that claims 1,3,5-6,12-13,17-19,32,46,51,53 and 56 are readable on the elected species, however; it is noted that claim 12 has been canceled in the pre-amendment filed on January 16, 2001, and will not be examined with the elected species.

Claim Rejections - 35 USC § 112

2. Claims 1,3,5-6,13,17-19,32,46,51,53 and 56 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The claimed rubber material having a transition temperature of 94-99 °F is critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Evidence that claims fail to correspond in scope with that which applicants regard as the invention can be found in Paper No. 22, filed May 9, 2000, in related US patent application 08/907,100. In that paper, applicant has stated that the Larson fabric support (US 5,807,291) does not have the claimed transition temperature (94-99 °F) at which the claimed rubbery material shrinks from its second shape and size to its first shape and size. In the present specification Applicant's invention appears to be directed to that which will return to its original

size or shape upon heating at or near the human body temperature. Therefore, "the transition temperature in the range of 94 to 99 degrees Fahrenheit" should be recited accordingly.

Furthermore, the independent claims appear to be much broader in scope with respect to the transition temperature.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claim 32 is rejected under 35 U.S.C. 102(e) as being anticipated by Beezhold (US 5563241).

Beezhold teaches in the "Background of the Invention" (column 1) that latex comprising about 33% rubber, 65% water and 2% protein, also known as 1,4-cis-polyisoprene is use to make gloves. Although Beezhold teaches that this is naturally occurring, it is the examiner's position that the structure would be identical to that which Applicant is claiming as synthetic. Therefore, the claim has been met.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,5,6,13,46 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuan et al. (US 4,891,409).

Kuan et al. teaches a shape transformable composition comprising at least one crystalline polymer and at least one elastomer. The compositions are generally characterized by low glass transition temperatures (<100 °C), fairly compatible polymers and homogenous mixtures (column 1, lines 48-63). The compositions can be shape transformed (stretched or compressed) under heat and retained in the transformed shape by cooling. Upon reheating, the compositions will return, or attempt to return to their original shape (state). Thus, the composition can be stretched or expanded under heat. Upon cooling, the compositions can be retained in the stretched or expanded state or permitted to partially shrink such that a partial expansion of the stretched state is retained. Upon reheating, the composition will shrink or be converted to its original state (column 2, lines 1-18). Suitable elastomers include non-crystalline random amorphous polymers including cis-1,4-polyisoprene either natural or synthetic (column 5, lines 49-59). Generally the crystalline component, the elastomer component, and the cross-linking agents are mixed together and heated to form a desired article.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

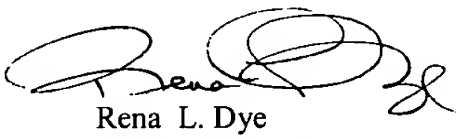
8. Claims 1,3,5-6,13,17-19,32,46,51,53 and 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6,221,447. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is recited broadly enough to include or encompass that which is recited in related US Patent '447 with respect to additional article structure, e.g. condoms, wound cover, etc., and would include the more narrowly recited transition range of 94-99 °F.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rena L. Dye whose telephone number is 703-308-4331. The examiner can normally be reached on Monday-Thursday 8:30 AM - 7:0 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Rena L. Dye
Primary Examiner
Art Unit 3627

R. Dye
January 6, 2003